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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,480

04/12/2004

Kazuhiro Yagishita

8305-245US (NP156-1)

3127

570

7590

04/02/2007

AKIN GUMP STRAUSS HAUER & FELD L.L.P.

ONE COMMERCE SQUARE

2005 MARKET STREET, SUITE 2200

PHILADELPHIA, PA 19103

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/822,480	Applicant(s) YAGISHITA ET AL.	
	Examiner Ellen M. McAvoy	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazato et al (6,569,818) in combination with Bardasz et al (6,764,982).

Applicants cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Nakazato et al ["Nakazato"] disclose a lubricating oil composition having a low phosphorus (P) content of 0.01 to 0.1 weight %, a sulfur content of 0.01 to 0.3 weight % and a sulfated ash of 0.1 to 1 weight %, which is comprised of (a) a major amount of mineral base oil having a low sulfur (S) content of at most 0.1 weight %, preferably at most 0.005 weight %, (b) an ashless alkenyl or alkyl-succinimide dispersant or derivative thereof in an amount of 0.01 to 0.3 weight % in terms of nitrogen atom content, (c) a metal-containing detergent such as an alkali metal or an alkaline earth metal salt of an alkylsalicylic acid in an amount of about 0.2 to 7 weight %, and may include other metal detergents such as sulfonate detergents, (d) a zinc dialkyl-dithiophosphate in an amount of 0.01 to 0.1 weight % in terms of a phosphorus content, and (e) an oxidation inhibitor selected from the group consisting of a phenol compound and an amine compound in an amount of 0.01 to 5 weight %. See column 2, line 25 to column 3, line 7.

Nakazato teaches that the lubricating oil composition may be used in internal combustion engines including gas engines. See column 1, lines 5-11. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the oil compositions such as the zinc dialkyldithiophosphate component of the prior art. Nakazato teaches that the lubricating oil compositions may contain other auxiliary additives such as phosphoric acid esters and phosphorous acid esters. Nakazato teaches that the additives can be incorporated into the lubricating oil compositions in an amount ranging from about 0.001 to 3 weight %. See column 7, line 59 to column 8, line 11. Applicants' invention differs by claiming a specific phosphorus acid ester compound, that of a triphosphate set forth by formula (1) in claim 1. However, as evidenced by Bardasz et al ["Bardasz"], such triphosphate compounds are well-known in the art. See the phosphorus-containing compounds represented by formula (B-I) in column 1. Bardasz also discloses a lubricating oil composition suitable for use in internal combustion engines having low phosphorus content, low sulfur content and low sulfated ash content. Having the prior art references before the inventors at the time the invention was made it would have been obvious to the skilled oil formulator to have added the triphosphate compound of Bardasz to the oil composition of Nakazato if its known imparted property was so desired. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, the motivation relied on by the examiner is the disclosure in Nakazato allowing for the addition of phosphorus-containing compounds to the lubricating oil compositions.

Conclusion

The Japanese references not considered on applicants' information disclosure statement are due to language; there are no english translations submitted with these references.

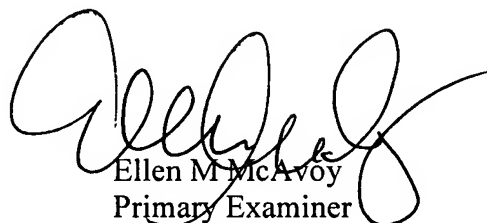
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 28, 2007